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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,679	03/12/2001	Geoffrey B. Rhoads	P0329	1863

23735 7590 11/24/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

RAMAN, USHA

ART UNIT	PAPER NUMBER
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2611

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DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,679

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Usha Raman

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-31-03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 2
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

2. Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

Drawings

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (US Pat. 6,564,380) in view of Cooperman et al. (US Pat. 5,613,004).

In regards to claim 1, Murphy discloses a method of providing a high bandwidth delivery system for distribution of streaming video, including media on demand and pay per view videos, over the Internet. Note column 3, lines 1-10, column 6, lines 25-30 and column 7, lines 46-48 of Murphy. Murphy discloses that the goal of media on demand services is to permit a user to select a program from a list of available titles. The user can request for a desired video by accessing the master website, that displays a list of all the video available with pricing information. Note column 7, lines 32-35 and column 12, lines 16-32 of Murphy. The master server also maintains the payment contract for user access of video. Therefore the video distribution system of Murphy provides means for allowing users to make a request for a video from a selection of available titles and a method of exchange of fee. Note column 11, lines 22-26 of Murphy. Murphy's video distribution system however lacks means of watermarking the video on the fly and then transmitting the watermarked video to the user.

Cooperman discloses a method of distributing video content on pay-by-use or meter-ware systems, where an online user incurs a charge each time they access a particular piece of content. Note column 1, lines 7-8, and column 4 lines 32-40 in Cooperman. When a consumer wishes to purchase a copy of the content from a publisher, the consumer signs a contract with the publisher that

identifies the consumer and terms of agreement. This contract, along with other information identifying the publisher, the authority, title, etc. is watermarked over the content and then distributed to the consumer. Note column 15 lines 1-38 in Cooperman. Since the publisher watermarks the consumer-publisher agreement on the video content after the user makes a request, the video is watermarked "on the fly" and then transmitted to the consumer.

Therefore it would have been obvious to one of ordinary skill to modify the method of Murphy with the teachings of Cooperman by including the step of watermarking the video after the request has been made and then deliver the watermarked content to the user, in order to embed some copyright data on the video in order to discourage piracy of the video content.

In regards to claims 2 and 8 Cooperman discloses that the agreement signed by the consumer contains consumer identification, which is embedded as a watermark on the video content and then transmitted to the user. Note column 15, lines 1-15 and lines 34-38 of Cooperman. Therefore the watermarked data contains at least one data recited in the claim.

6. Claims 3, 4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (US Pat. 6,564,380) in view of Cooperman et al. (US Pat. 5,613,004) as applied to claim 2 above, and further in view of Moskowitz et al. (US Pat. 5,822,432).

In regards to claim 3, 4, 7 and 9, Cooperman discloses embedding consumer identification, publisher identification, title, copyright holder and other

information as a watermark for the video content. While the method of Murphy in view of Cooperman discloses embedding consumer identification, and publisher identification, (i.e. Cooperman discloses watermarking more than one data) Cooperman does not specifically disclose embedding hyperlinks, URL or other forms of Internet address identifying the content requester's Internet address and/or the content distributor's Internet address.

Moskowitz et al. disclose that, in addition to watermarking "metering" watermarks on content that identify the consumer identification, license agreement and terms and usage, watermarks containing other pertinent information about the content, such as where to locate other copies of the purchased content or similar contents can be included in the content. An example of such information watermarked is watermarking the video content with one or more URLs. Note column 9, lines 29-40 in Moskowitz et al.

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the method of Murphy in view of Cooperman et al. by watermarking the content requester and/or distributor Internet address over the video content, thus watermarking up to three data from that listed in the claim and providing additional information about the consumer and/or publisher, to provide a plurality of identifiers for identifying authorized or unauthorized copies of content.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (US Pat. 6,564,380) in view of Cooperman et al. (US Pat. 5,613,004) as applied

to claim 2 above, and further in view of Moskowitz (US Pat. 5,822,432) and Spagna et al. (US Pat. 6,587,837).

In regards to claim 5, the method of Murphy in view of Cooperman watermarks the video content with consumer identifier. While the method of Murphy in view of Cooperman discloses watermarking the video with more than one data, it does not disclose other data from that listed in the claim.

Moskowitz et al. disclose that, in addition to watermarking "metering" watermarks on content that identify the consumer, watermarks can contain information on where to locate other copies of the content or similar content by watermarking the content with one or more URLs. Note column 9, lines 29-40 in Moskowitz et al.

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the method of Murphy in view of Cooperman by watermarking the content requester and/or distributor Internet address over the video content, thus watermarking up to three data from that listed in the claim and providing additional information about the consumer and/or publisher, to provide a plurality of identifiers for identifying authorized or unauthorized copies of content.

The modification of Murphy in view of Cooperman and Moskowitz has method of watermarking only three of the listed data in the claim (consumer identifier, requester internet address and distributor internet address). It still

lacks the fourth data, the date identifier from the listed watermark data in the claim.

Spagna et al. teach that the content can be watermarked with a date identifier, such as the date the transaction was processed. Note column 11, lines 13-17 in Spagna et al.

Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the method of Murphy in view of Cooperman and Moskowitz by watermarking the content with a date identifier as taught by Spagna et al. in order to provide means of identifying the processing date of the content.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (US Pat. 6,564,380) in view of Cooperman et al. (US Pat. 5,613,004) as applied to claim 2 above, and further in view of Spagna et al. (US Pat. 6,587,837).

In regards to claim 6, the method of Murphy in view of Cooperman does not disclose watermarking video data with an identifier of the date. Spagna et al. disclose the method watermarking video content with an identifier of the date. Note column 11, lines 13-17 in Spagna et al. Therefore it would have been obvious to one of ordinary skill to modify the method of Murphy in view of Cooperman by watermarking the video content with an identifier of date as taught by Spagna et al. in order to provide means of identifying the processing date of the content.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on M-F: 9am -7pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

UR
10-31-03


**VIVEK SRIVASTAVA
PRIMARY EXAMINER**